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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/036,236 03/06/98 OLIVER

D 005-905-300

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LM01/1207

EXAMINER

THOMPSON JR,F

ART UNIT PAPER NUMBER

2765

DATE MAILED:

12/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

| | |
|---------------------------------|-------------------------------|
| Application No. 09/036,236 | Applicant(s) Oliver et al. |
| Examiner Forest Thompson Jr. | Group Art Unit 2765 |



Responsive to communication(s) filed on Oct 1, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-80 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

Claim(s) _____ is/are allowed.

Claim(s) 1-80 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on Oct 1, 1999 is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 5, 8, 9

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. As per the rejection of claims 1-34 under 35 U.S.C. § 103, the rejections are maintained due to applicants' unpersuasive argument as set forth in section 9 of this action and the requirements of MPEP 1608 and 2308.01, as quoted below.

2. The amendment filed on 1 October 1999 and the supplemental amendment filed 7 October 1999 are not sufficient to overcome the **Teper et al.** (Patent No. 5,815,665), **Reeder** (Patent No. 5,852,812) and **Reuhl et al.** (Patent No. 5,873,069). references.

Applicants' original claims are claims 1-34. Applicants have added, by amendment, the new claims 35-80, which are copied from the 46 claims of **Teper et al.**, see pg. 3 last paragraph of paper #8. Claims 1-80 are now pending.

3. Applicants have faxed 2 new references to USPTO for inclusion into the application. These were copies of claims only from patents #5,909,492 and 5,899,980. This is improper procedure as the entire patent of each must be considered. Examiner has included and considered the entire patents, not just the claims.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (See Serial No. 09/036,236, Paper No.4). The text of those sections of

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Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.

5. This action is responsive to the amendment filed 1 October 1999, and the supplemental amendment filed 7 October 1999.

Drawings

6. The corrected or substitute drawing (fig. #1) was received on 7 October 1999. Applicants' drawing changes are approved. Additionally, applicants' amendment (paper #7) amends the specification to identify components of the drawings. Accordingly, the objections to fig. 1 and 2 are withdrawn.

7. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

8. Amendments to the specification to cure minor informalities have been noted by examiner and are not objected to.

Claim Objections

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9. Amendments to the claims in response to examiner's objections to cure minor informalities and/or lack of antecedent type objections are approved by examiner. Accordingly, the objections to the claims on these grounds are withdrawn.

Claim Rejections - 35 U.S.C. § 112

10. Amendments to the claims in response to examiner's rejections in paper #4 are adequate to overcome these rejections. Therefore, these rejections are withdrawn.

Claim Rejections - 35 U.S.C. § 103

11. Claims 1-80 are rejected as being unpatentable over the prior art, as stated in the following paragraphs.

12. Claims 1-34 were rejected under 35 U.S.C. 103(a) in the First Action (paper #4). Applicants have failed to provide reasonable justification for allowance of these claims over prior art. Therefore, the rejection of claims 1-34 as stated in paper #4 is maintained.

Am 13. Claims 35-80 are rejected under 35 U.S.C. ~~103(a)~~^{102(e)} as being unpatentable over Teper et al. Applicants state in paper #8 at pg. 3 last paragraph that these claims are copied from Teper et al. Therefore, they are rejected as being unpatentable over prior art (Teper et al.).

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Response to Arguments

14. The arguments filed in the amendment filed on 1 October 1999 and the supplemental amendment filed 7 October 1999 by applicants have been fully considered but are not persuasive.

15. As per the applicants' request for an interference with Teper et al., MPEP 2308 states

37 CFR 1.608. Interference between an application and a patent; prima facie showing by applicant.

(b) When the effective filing date of an application is more than three months after the effective filing date of a patent, the applicant, before an interference will be declared, shall file evidence which may consist of patents or printed publications, other documents, and one or more affidavits which demonstrate that applicant is prima facie entitled to a judgment relative to the patentee and an explanation stating with particularity the basis upon which the applicant is prima facie entitled to the judgment. Where the basis upon which an applicant is entitled to judgment relative to a patentee is priority of invention, the evidence shall include affidavits by the applicant, if possible, and one or more corroborating witnesses, supported by documentary evidence, if available, each setting out a factual description of acts and circumstances performed or observed by the affiant, which collectively would prima facie entitle the applicant to judgment on priority with respect to the effective filing date of the patent. To facilitate preparation of a record (§ 1.653(g)) for final hearing, an applicant should file affidavits on paper which is 21.8 by 27.9 cm. (8 ½ x 11 inches). The significance of any printed publication or other document which is self-authenticating within the meaning of Rule 902 of the Federal Rules of Evidence or § 1.671(d) and any patent shall be discussed in an affidavit or the explanation. Any printed publication or other document which is not self-authenticating shall be authenticated and discussed with particularity in an affidavit. Upon a showing of good cause, an affidavit may be based on information and belief. If an

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examiner finds an application to be in condition for declaration of an interference, the examiner will consider the evidence and explanation only to the extent of determining whether a basis upon which the application would be entitled to a judgment relative to the patentee is alleged and, if a basis is alleged, an interference may be declared.

Under 37 CFR 1.608, *an applicant seeking to provoke an interference with a patent is required to submit evidence which demonstrates that the applicant is prima facie entitled to a judgment relative to the patentee. Evidence must be submitted when the effective filing date of the application is more than 3 months after the effective filing date of the patent.* The evidence may relate to patentability and need not be restricted to priority, but if the evidence shows that the claims of the application are not patentable, the claims in the application will be rejected. The applicant can file a request for reexamination of the patent, if applicable.

2308.01 Patent Has Filing Date Earlier Than Application

When an applicant attempts to provoke an interference with a patent, the examiner must determine the effective filing dates of the application and of the patent; only the patent's effective United States filing date will be considered. Any claim of foreign priority by the patentee under 35 U.S.C. 119 will not be taken into account when determining whether or not an interference should be declared, in order to be consistent with the holding in *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966), that the effective date of a United States patent as a reference is not affected by the foreign filing date to which the patentee is entitled under 35 U.S.C. 119. If the patentee is determined to be entitled to the benefit of a prior United States application as to claimed subject matter involved in the interference, that application must be listed on the PTO-850 form (see MPEP § 2309).

Also, the following requirements apply:

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If the effective filing date of the application is more than 3 months after the effective filing date of the patent, 37 CFR 1.608(b) requires that the applicant must file (1) evidence, such as patents, publications and other documents, and one or more affidavits or declarations which demonstrate that applicant is prima facie entitled to a judgment relative to the patentee, and (2) an explanation stating with particularity the basis upon which the applicant is prima facie entitled to the judgment.

If an applicant is claiming the same invention as a patent which has an earlier effective United States filing date but there is not a statutory bar against the application, and the applicant has not submitted the items required by 37 CFR 1.608(a) or (b), as appropriate, the application should be rejected under 35 U.S.C. 102(e) /103. A statement should be included in the rejection that the patent cannot be overcome by an affidavit or declaration under 37 CFR 1.131 but only through interference proceedings. Note, however, 35 U.S.C. 135(b) and MPEP § 2307. The applicant should also be advised that an affidavit under 37 CFR 1.608(b) or evidence and an explanation under 37 CFR 1.608(b), as appropriate, must be submitted and it should be stated, if applicable, that the patentee has been accorded the benefit of an earlier U.S. application.

16. The following priority dates were used in this evaluation:

- Teper et al. (5,815,665) - filing date: Apr. 3, 1996, priority date: Apr. 3, 1996
- Applicants' filing (09/036,236) - filing date: Mar. 6, 1998, priority date: Mar. 7, 1997

based on provisional application #60/040,223

17. Applicants have not submitted affidavits as required by MPEP, as quoted in paragraph 14 above.

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AM
18. Based on the MPEP, as stated in paragraph 14 above and paragraphs 15-16 above, **an interference is not granted** to applicants. Examiner rejects applicants' claims under 35 U.S.C. 103 as being unpatentable over **Teper et al.** for the reasons stated in paragraphs 10, 11 and 12 above. Applicants' request for an interference with Teper et al. is not supported by the documentation provided by the applicants, as required by the MPEP which is quoted above.

Conclusion

19. Claims 1-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper et al. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson whose telephone number is (703) 306-5449. The examiner can normally be reached Monday-Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.


December 3, 1999 /FOT



ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINE